

R E M A R K S

Claims 9, 10, 14 to 17 and 21 as set forth in Appendix I of this paper are remain in this case. Claims 11, 12, 18, 19 and 20 have been canceled and Claims 9, 14 and 15 have been amended as indicated.

Applicants have amended Claims 9 and 15 to read on the subject matter previously defined in Claims 20 and 19, respectively, and have corrected Claim 14 to depend upon Claim 9. No new matter has been added. The foregoing amendment merely serves to reduce the issues for appeal and does not alter the claims in a manner which would necessitate further search and/or consideration by the Examiner. Entry of the amendment at this stage of proceedings is therefore deemed equitable. Favorable action is solicited.

The Examiner has maintained that the subject matter of Claims 9, 10, 14 to 17 and 21 is unpatentable under 35 U.S.C. §103(a) in light of the disclosure of *Hilti et al.* (US 5,814,688) or the disclosure of *Zilg et al.* (US 6,197,849).

The Examiner takes the position that the respective references render the molding composition comprising particular styrene-acrylonitrile copolymers which is defined in applicants' independent Claim 15 *prima facie* obvious, and that the particular properties of the composition, or the methods of imparting those properties to a molding composition comprising styrene-acrylonitrile copolymers in accordance with applicants' independent Claims 9 and 21, are inherent in the prior art compositions. However, it is well established that the fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness<sup>1)</sup>. Regardless of the type of disclosure, the prior art must provide some motivation to one of ordinary skill in the art to make the claimed selection, obviousness under Section 103(a) re-

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1) In re Baird, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (CAFC 1994): "The fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious."; In re Jones, 958 F.2d 347, 350, 21 USPQ2d 1941, 1943 (CAFC 1992) (Federal Circuit has "decline[d] to extract from Merck & Co. v. Biocraft Laboratories Inc., 874 F.2d 804, 10 USPQ2d 1843 (CAFC 1989)] the rule that... regardless of how broad, a disclosure of a chemical genus renders obvious any species that happens to fall within it."). See also In re Deuel, 51 F.3d 1552, 1559, 34 USPQ2d 1210, 1215 (CAFC 1995).

quires, inter alia, that the prior art suggested to those of ordinary skill in the art that they should make the specific composition which is claimed<sup>2</sup>). Accordingly, some motivation to select the claimed species or subgenus must be taught by the prior art<sup>3</sup>). The Examiner's statement "*Case law has well established that it is prima facie obvious to select ingredients from a list and have them function in an expected manner*"<sup>4</sup>) is, in light of the foregoing, not deemed to be well taken, particularly since the respective statement is not accompanied by a reference to specific case law supporting it. Only a specification of the case law referenced in the Examiner's statement would allow applicants to determine whether the facts in the prior legal decision(s) are sufficiently similar to the circumstances in the present case to draw a conclusion that applicants' invention is rendered *prima facie* obvious by the generic teachings of the prior art applied by the Examiner. Moreover, a comparison of the facts before the Court in *In re Jones*<sup>5</sup>) and the circumstances in this case shows that the generic recitation of countless polymeric materials as is provided by *Hilti et al.*<sup>6</sup>) or by *Zilg et al.*<sup>7</sup>) is insufficient to suggested to those of ordinary skill in the art that they should select styrene copolymers as referenced in applicants' Claim 21, or that they should select the particular group of styrene-acrylonitrile copolymers which is defined in applicants' Claims 9 and 15. The invention of *Jones* related to "The 2-(2'-aminoethoxy) ethanol salt of dicamba." and the closest prior art, *Richter*, disclosed dicamba in free acid, ester and in salt forms, including ammonium salts, without, however, specifically mentioning the 2-(2'-aminoethoxy) ethanol salt. The Court noted: "*Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence)*"

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2) *In re Vaack*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (CAFC 1991); *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (CAFC 1988); *Hodosh v. Block Drug Co.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (CAFC 1986).

3) See, e.g., *Deuel*, 51 F.3d at 1558-59, 34 USPQ2d at 1215: "No particular one of these DNAs can be obvious unless there is something in the prior art to lead to the particular DNA and indicate that it should be prepared."; *Baird*, 16 F.3d at 382-83, 29 USPQ2d at 1552; *Bell*, 991 F.2d 781, 784, 26 USPQ2d 1529, 1531 (CAFC 1993): "Absent anything in the cited prior art suggesting which of the 1036 possible sequences suggested by Rinderknecht corresponds to the IGF gene, the PTO has not met its burden of establishing that the prior art would have suggested the claimed sequences."

4) Sentence bridging pages 2 and 3 of the Office action, emphasis original.

5) *Id.*, fn. (1) page 2 of this paper.

6) Col. 2, indicated line 64, to col. 6, indicated line 13, of *US 5,814,688*.

7) Col. 5, indicated line 40, to col. 9, indicated line 63, of *US 6,197,849*.

that one of ordinary skill in the herbicidal art would have been motivated to make the modifications of the prior art salts necessary to arrive at the claimed 2-(2'-aminoethoxy) ethanol salt" and reversed the Board's finding of obviousness.

The facts before the Court in In re Jones resemble the circumstances pertaining where applicants' Claim 15 is concerned in that neither *Hilti et al.* nor *Zilg et al.* mention mica which is employed in accordance with applicants' invention. In contrast to the facts in In re Jones, however, applicants' Claim 15 further requires the selection of a specific and particular styrene-acrylonitrile copolymer from the styrene-acrylonitrile polymers generically mentioned in the enumeration of the countless polymeric materials provided by *Hilti et al.* or by *Zilg et al.* and applicants' specific combination results in a particular property which is neither suggested nor implied by the teaching of *Hilti et al.* or *Zilg et al.* Accordingly, the differences between the prior art teaching which is provided by *Hilti et al.* or by *Zilg et al.* and the subject matter of applicants' Claim 15 are by far greater than the differences between the prior art teaching and the claimed subject matter in In re Jones. The same applies *mutatis mutandis* where the method of applicants' Claim 9 is concerned since the method requires the specific and particular styrene-acrylonitrile copolymers defined in Claim 15 and aims at conveying the particular property to those styrene-acrylonitrile copolymers.

The facts before the Court in In re Jones also resemble the circumstances pertaining where applicants' Claim 21 is concerned in that neither *Hilti et al.* nor *Zilg et al.* mention mica which is employed in accordance with applicants' invention. In contrast to the facts in In re Jones, however, applicants' Claim 21 is not drawn to a composition of matter but relates to a method which aims at achieving a particular result. While the composition of matter claimed by *Jones* exhibited the properties known from the prior art, applicants' method achieves a result which is neither suggested nor implied by the teaching of *Hilti et al.* or *Zilg et al.* Accordingly, the differences between the prior art teaching which is provided by *Hilti et al.* or *Zilg et al.* and the subject matter of applicants' Claim 21 are by far greater than the differences between the prior art teaching and the claimed subject matter in In re Jones.

The Examiner's position that the prior art compositions possess the particular properties which applicants found for the composition defined in Claim 15 or which are achieved in accordance with applicants' methods is not deemed to be well taken. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic<sup>8</sup>). To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient<sup>9</sup>). Obviousness cannot be predicated on what is not known at the time an invention is made, even if the inherency of a certain feature is later established<sup>10</sup>).

The Examiner's position requires either that a person of ordinary skill in the art would have made the specific selection which is necessary to arrive at the requirements of applicants' claims, or that the particular properties which are achieved in accordance with applicants' invention are independent from the nature and the characteristics of the polymer component. The first requirement is not met because -as addressed above- neither the teaching of *Hilti et al.* nor the teaching of *Zilg et al.* suggest the particular selection which is necessary to arrive at the compositions referenced in applicants' claims. The second requirement underlying the Examiner's position lacks the necessary support by extrinsic evidence.

In light of the foregoing it is therefore respectfully requested that the rejection under 35 U.S.C. §103(a) based on either one of the teachings of *Hilti et al.* and *Zilg et al.* be withdrawn. Favorable action is solicited.

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8) In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (CAFC 1993); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

9) In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (CAFC 1999).

10) In re Rijckaert, id., ftn. (8).

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Encl.: THE LISTING OF CLAIMS (Appendix I)

HBK/BAS